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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,504	04/25/2002	Oswald Wolff	WOLFF,D ET AL (PCT)	2655
25889	7590	01/27/2006	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			PHAM, HUONG Q	
			ART UNIT	PAPER NUMBER
			3764	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/018,504	Applicant(s) WOLFF ET AL.	
	Examiner Huong Q. Pham	Art Unit 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/9/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 3, 5- 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isaacson (4,479,495) in view of the reference DE 330011A1 .

As for claim 11, Isaacson teaches a device (capable of being used as a device for treatment or therapy of Ledderhose's disease or hypermobile foot joints) having a functional component 10 adapted to the outer contour of a wearer's lower leg and is capable of surrounding the lower leg near the upper ankle joint so that when the device is worn the mobility of the wearer's upper ankle joint and the Achilles tendon is not restricted; and a pad 14 having a convex surface (note figures 3D and 7) arranged on an inside portion of the functional component 10 so that when the device is worn the convex surface is capable of resting anterolaterally on the wearer's leg against the fibula and tibia in the region of the wearer's tibiofibular syndesmosis so that the tibiofibular syndesmosis is stabilized. The reference DE 330011A1 teaches a cuff made of stiff plastic that can be shaped to conform to a specific foot and can be configured with cushion (last and first paragraphs of pages 3-4). In view of the teaching of the

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reference DE 330011A1, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use stiff material for the functional component 10 of Isaacson in order to provide firmer support around the upper ankle joint area of a user. Note that the substitution of one material for another well known material, based on its well known properties, is obvious to one of ordinary skill in the art, and does not provide any unobvious result, and therefore is not patentable over prior art. As for claims 3, 5, note the closing elements 12 (figure 1) and the hooks and loops surfaces. As for claims 6-8, note the cuff of the reference DE 330011A1 (figures 1,2).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Isaacson (4,479,495) in view of the reference DE 330011A1, and further in view of Sweitzer (4,299,214).

The reference DE 330011A1 teaches a cuff made of stiff plastic with plural belts for securing the cuff to a user. Sweitzer teaches a cuff made of stiff plastic material wherein the closing elements are belts and buckles. In view of the teachings of the reference DE 330011A1 and Sweitzer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use stiff material for the functional component 10 of Isaacson in order to provide firmer support around the upper ankle joint area of a user, and to substitute the closing elements (12, hooks and loops surfaces) of Isaacson with plural belts and buckles in order to firmly secure the stiff cuff to a user.

Claim 9, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isaacson (4,479,495) in view of the reference DE 330011A1, and further in view of Mason et al (4,938,777).

Mason et al teaches an ankle orthosis made of polycarbonate or stainless steel. In view of the teaching Mason et al, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use polycarbonate or stainless steel for the stiff cuff of Isaacson and the reference DE 330011A1 in order to provide the desired degree of rigidity.

Applicant's arguments with respect to the claims have been considered but are not persuasive. Note the comments relative to the claims above. Applicant argues that the convex curved side of Isaacson is attached to the flexible strap, rather than to the part that is in contact with the wearer's leg. Note figures 3D and 7 of Isaacson (for figure 7, the top part has a convex surface). Applicant argues on page 6 that "the contact point of Isaacson is too narrow to rest against". Note that Isaacson device can be applied to the wearer in the region of the wearer's tibiofibular syndesmosis (or at least to a part of the region) and is capable of stabilizing the tibiofibular syndesmosis to some degree .Also, note that applicant does not specify in the claims how large or how wide the contact point is to provide the necessary stabilization.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272 - 4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 23, 2006

A handwritten signature in black ink, appearing to read "Michael A. Brown", with a long horizontal flourish extending to the right.

MICHAEL A. BROWN
PRIMARY EXAMINER